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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,836	06/27/2003	Hung T. Le	LETU 8431US	7612

1688 7590 07/14/2004

POLSTER, LIEDER, WOODRUFF & LUCCHESI
12412 POWERS COURT DRIVE SUITE 200
ST. LOUIS, MO 63131-3615

EXAMINER

PHAM, MINH CHAU THI

ART UNIT PAPER NUMBER

.1724

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,836

Applicant(s)

LE ET AL.

Examiner

Minh-Chau T. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/1/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarroll (4,488,889) in view of Schmitz et al (5,423,903).

McCarroll discloses an in line air filter for use in the air intake system of a truck comprising two housings (16 & 19), a filter (48), housing grommets (22) and 2 clamps (18 & 26). McCarroll further discloses the two housings having a protrusion (30) for fastener, and the grommets being ring shaped configured to fit within the opening of the generally cylindrical shaped portion of the 2 housings (see Fig. 6). McCarroll also discloses a process of using an in line air filter for filtering air for an internal combustion engine comprising the steps of providing a filter, providing a main housing with 2

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housings, 2 grommets and 2 clamps, assembling the filter onto the housing to make and in line air filter, and installing the in line air filter onto a component of an intake system of a vehicle. Claims 1-25 differ from the disclosure of McCarroll in that the in line air filter has 2 mesh filters. Schmitz et al disclose 2 mesh filters (22 & 26) sandwiching a filter media (24). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide 3 mesh filters as taught by Schmitz et al in the filter apparatus of McCarroll to provide a support for a filter media as well as to act as a screen or prefilter to filter out larger particulates in the air stream.

Claims 6-20 call for the shape of housings being a cone-shaped housing. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the housing as any desired shape such as cylindrical or conical housing since it is well settled that mere change of shape without affecting the function of the part would have been an obvious design modification. See Eskimo Pie Corp v. Levous et al 3 USPQ 23.

As to the numerical requirements in claims 15, 16, 19, 20, 22, 23 and 25, the specification contains no disclosure of either the critical nature of these requirements or any unexpected results arising therefrom, as such these requirements would be arbitrary and therefore obvious. Applicants must show that these requirements are critical. In re Woodruff, 16 USPQ 2d 1934.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Leo (5,807,415) discloses a collapsible air filter frame.
- LaBarge et al (6,752,859 B2) disclose an air cleaner assembly.
- Gould et al (5,350,444) disclose a filter for an air intake.
- Schmidt et al (4,838,901) disclose a lightweight filter.
- Liu et al (4,972,957) disclose a particle concentrating sampler.
- Gieseke et al (6,221,122 B1) disclose a filter element.
- Milano, Jr. et al (6,568,685 B2) disclose a seal assembly.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh-Chau T. Pham whose telephone number is (571) 272-1163. The examiner can normally be reached on Mon/Tues/Thur/Fri 7:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Minh-Chau Pham', written in a cursive style.

Minh-Chau Pham

Patent Examiner

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July 12, 2004